

## **REMARKS**

In the final office action, the examiner rejected claims 1-25. Reconsideration and allowance of all pending claims are requested in view of the following remarks.

### **Rejections Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph**

In the final office action, the examiner rejected claims 1-25 under 35 U.S.C. § 112, second paragraph. In particular, the examiner rejected claims 1-25, stating that “exam specifications” “are not a term of art nor are they specifically defined in the specification. Therefore, these claims are indefinite on their face. The examiner has interpreted exam specifications to mean tests.” *See* Final office action, page 3. In addition, the examiner rejected independent claim 11, stating that “[a] manner” is a relative phrase that does not define steps used or a standard operating procedure for how one would practice the instant invention. Therefore this claim is indefinite on its face. The examiner has interpreted a manner to mean an order.” *See id.*

### ***Deficiencies of the Rejection of Claims 1-25***

The applicants strongly disagree with the examiner’s assertion that the term “exam specifications” is indefinite. More specifically, the applicants contend that one skilled in the art would understand the term “exam specifications” by its plain meaning as “the specifications by which an exam is to be performed.” Furthermore, the applicants note that the specification of the present application clearly supports this interpretation. For example, page 11, lines 1-7 of the specification of the present application states:

The details of each exam are also provided in the decision tree. The details provided for an exam comprise a set of exam specifications and expected results for the exam. *The exam specifications specify the manner in which the exam is to be performed at acquisition modality 106, recommendations for the exams, settings, protocols, regions to be examined, and any other relevant details needed or useful in performing the exams in a manner desired by the referring physician.* The expected results for an exam are the results expected by referring physician 102 from the exam.

*See Application, page 11, lines 1-7 (emphasis added).*

Therefore, the applicants contend that it is clear from the specification that “exam specifications” specify the manner in which an exam is to be performed, including “recommendations for the exams, settings, protocols, regions to be examined, and any other relevant details needed or useful in performing the exams in a manner desired by the referring physician.” *See id.* As such, the applicants contend that one skilled in the art would understand the term “exam specifications.”

In addition, the applicants note the examiner’s interpretation of the term “exam specifications” as merely “tests” is clearly improper in light of these support passages in the specification. More specifically, the applicants contend that “tests” is clearly a broader (and quite different) interpretation than what is described in the specification and what would be understood by those skilled in the art. If relevant at all, “tests” may have a meaning closer to “exams,” but not the specifications for such exams. As such, the applicants respectfully request withdrawal of the rejection of claims 1-25 under 35 U.S.C. § 112, second paragraph.

#### ***Deficiencies of the Rejection of Independent Claim 11***

The applicants also strongly disagree with the examiner’s assertion that “a manner in which the exam is to be performed” is indefinite. More specifically, the applicants contend that one skilled in the art would understand that the “manner” in which an exam is to be performed generally means the “way” in which an exam is to be performed. In particular, as described above, the specification of the present application clearly identifies that specifications of the performed exams include, for instance, “recommendations for the exams, settings, protocols, regions to be examined, and any other relevant details needed or useful in performing the exams in a manner desired by the referring physician.” *See id.* Therefore, the applicants contend that one skilled in the

art would understand that the “manner” in which an exam is to be performed may be defined by the exam specifications, which define the “way” in which the exams may be performed. As such, the applicants respectfully request withdrawal of the rejection of independent claim 11 under 35 U.S.C. § 112, second paragraph.

### **Rejections Under 35 U.S.C. § 103**

In the final office action, the examiner rejected claims 1-10 under 35 U.S.C. § 103(a) as obvious over Campbell et al. (U.S. Patent No. 6,047,259; hereinafter “Campbell”) in view of Teshima (U.S. Patent No. 6,272,470; hereinafter “Teshima”). In addition, the examiner rejected claims 11-25 under 35 U.S.C. § 103(a) as obvious over Teshima in view of Campbell. The applicants respectfully traverse these rejections.

### ***Legal Precedent and Guidelines***

The burden of establishing a *prima facie* case of obviousness falls on the examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). In establishing a *prima facie* case for obviousness, “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long-felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1729 (2007) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). It is often necessary “to look to interrelated teachings of multiple patents, the effects of demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art.” *Id.* This analysis should be made explicit. *Id.* (citing *In re Khan*, 441 F.3d 977, 988 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory

statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Additionally, a claim having several elements is *not* proved obvious merely by demonstrating that each of its elements was known in the prior art. *Id.* In this regard, the Supreme Court recently reiterated that it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does...because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* As such, the obviousness inquiry does not hinge on demonstrating that elements were known in the art. Rather, the obviousness inquiry focuses on whether the claimed subject matter would have been obvious to persons having ordinary skill in the art in view of the demands and practices of the design community at the time of filing of the application.

*See id.*

When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

***Deficiencies of the rejection of independent claims 1, 11, and 14 based on a hypothetical combination of Teshima and Campbell.***

The applicants contend that Teshima and Campbell, whether alone or in hypothetical combination, fail to disclose each element of independent claims 1, 11, and 14. For instance, independent claims 1, 11, and 14 all generally recite, *inter alia*, “sending a request for ordering exams to be performed on a patient to a scheduler, the request being sent by a referring physician *in the form of a decision tree of exams to be performed on the patient.*” (Emphasis added.) In addition, independent claims 1, 11, and 14 all generally recite, *inter alia*, “requesting additional exams to be performed on the patient based on an analysis of results of the ordered exams, the analysis being done by the analyst and the additional exams being requested by the analyst *until an end of the decision tree is reached.*” (Emphasis added.)

The applicants contend that a hypothetical combination of Teshima and Campbell fails to disclose “sending a request for ordering exams to be performed on a patient to a scheduler, the request being sent by a referring physician *in the form of a decision tree of exams to be performed on the patient,*” as generally recited by independent claims 1, 11, and 14. In rejecting independent claims 1, 11, and 14, the examiner acknowledged that Campbell does not disclose these recited features. *See, e.g.*, Final office action, page 4. Rather, the examiner relied exclusively on Teshima for their teaching. *See, e.g., id.* at pages 4-5 and 14-15. In particular, the examiner cited “at least Fig. 6, column 4, lines 16-20, column 10, lines 34-48” and “at least FIG 6 and associated text in column 11, lines 8-17” as disclosing the recited features. *See, e.g., id.* at pages 5 and 14-15. However, the applicants contend that none of these passages from Teshima discloses that a referring physician sends a request for ordering exams *in the form of a decision tree of exams to be performed on a patient.* Rather, the three passages cited by the examiner read as follows:

The patient's main complaint and the observed physical findings are then entered. If necessary, an order is placed for an examination or medication. Otherwise, while a treatment is undertaken, the contents of a therapy are entered.

Teshima, column 4, lines 16-20.

To begin with, the processing in FIG. 6 will be described. The electronic clinical recording system 3 reads information described in an operator card from the operator card input unit 14, and checks an operator and his/her qualification (step 101). With this check, an operator who has not had his/her name registered is excluded.

It is then judged from the input information sent from the input unit 8 or 9 whether or not this consultation is the first consultation or the second or subsequent consultation, or whether or not a consultation record is merely referenced (steps 102 and 103). If it is judged that this consultation is the first consultation, control is passed to a series of steps 104 to 109. If it is judged that this consultation is the second or subsequent consultation, control is passed to a series of steps 110 to 115. If it is judged that a consultation record is merely referenced, control is passed to a series of steps 116 to 120.

*Id.* at column 10, lines 34-48.

When setting the new creating mode is completed, the electronic clinical recording system 3 reads the contents of the patient card 6 such as basic information via the patient card input/output apparatus 13, and lists them (steps 105 and 106 in FIG. 6). An input table of a consultation record is then created at step 107. At step 108, the main complaint of a patient, the findings of consultation, the name of a disease, and information of a consultation and treatment such as orders (information of a consultation) are input via the text input unit 8 and pointing device 9.

*Id.* at column 11, lines 8-17.

As stated above, the applicants contend that none of these passages from Teshima discloses that a physician sends a request for ordering exams *in the form of a decision tree of exams to be performed on the patient*. Rather, the first passage merely states that an examination may be ordered based on a patient's main complaint and observed physical

findings. In addition, the second passage merely describes the first few steps in the process of a physician entering consultation information into a portable patient identification card (e.g., does the information being input into the portable patient identification card relate to a first consultation or a subsequent consultation). Finally, the third passage merely describes how contents of the portable patient identification card may be read, previous consultation records may be listed, and a new consultation record may be created and updated. Nowhere in these three passages does Teshima even suggest that a physician sends a request for ordering exams *in the form of a decision tree of exams to be performed on the patient*. Furthermore, the applicants contend that there are no other passages within Teshima or Campbell that disclose this recited subject matter.

Indeed, the applicants contend that Teshima is primarily directed to a system wherein healthcare-related information, such as examination and biomedical information, may be stored within a portable patient identification card, which may remain in the possession of the patient most of the time. However, Teshima does not disclose the use of requested exams *in the form of a decision tree of exams to be performed on the patient*. For instance, Figure 6, relied upon by the examiner, merely discloses a process by which the portable patient identification card may be updated and maintained. For example, the process illustrated in Figure 6 represents steps that may be taken by a physician in entering consultation record information relating to a *single consultation* into the portable patient identification card for the patient (e.g., does the information being input into the portable patient identification card relate to a first consultation or a subsequent consultation). The applicants contend that the process illustrated in Figure 6 of Teshima clearly does not represent a *decision tree of exams to be performed on a patient*, as recited by independent claims 1, 11, and 14.

In contrast, embodiments of the present application are generally directed toward enabling a physician to send a request for a series of exams in the form of a *decision tree of exams to be performed on a patient*. *See, e.g.*, Application, FIG 2; page 10, lines 16-21. In other words, the physician may place a request for a series of exams, along with the details of each exam, arranged in a tree structure. *See, e.g.*, Application, FIG. 3, page 10, lines 23-26. The applicants again note that Teshima does not disclose that a physician may send a request for ordering a series of exams in the form of a *decision tree of exams to be performed on a patient*. As such, the applicants reiterate that Teshima does not disclose “sending a request for ordering exams to be performed on a patient to a scheduler, the request being sent by a referring physician *in the form of a decision tree of exams to be performed on the patient*,” as recited by independent claims 1, 11, and 14.

In addition, since Teshima fails to disclose the use of requested exams *in the form of a decision tree of exams to be performed on the patient*, the applicants further contend that Teshima does not disclose “requesting additional exams to be performed on the patient based on an analysis of results of the ordered exams, the analysis being done by an analyst and the additional exams being requested by the analyst *until an end of the decision tree is reached*,” as recited by independent claims 1, 11, and 14. More specifically, since Teshima does not disclose requested exams *in the form of a decision tree of exams to be performed on the patient*, Teshima cannot possibly disclose that additional exams are requested by an analyst *until an end of the decision tree is reached*,” as recited by independent claims 1, 11, and 14.

In the Response to Arguments section of the final office action, the examiner stated that “both Campbell and Teshima’s systems and method provide deductive reasoning needed to make a decision and request medical examinations. A decision tree has no systematic logic, needed to make a decision. A doctor could simply utilize the resulting medical examinations of his/her patients to determine if additional medical

examinations or doctor's appointments are further needed." See Final office action, page 22.

Therefore, it appears that the examiner, instead of identifying any passages in Teshima or Campbell that disclose the recited features, has merely attempted to downplay the significance of the recited features. More specifically, the applicants again note that the examiner has not identified any passages in Teshima or Campbell that disclose "sending a request for ordering exams to be performed on a patient to a scheduler, the request being sent by a referring physician *in the form of a decision tree of exams to be performed on the patient*," as recited by independent claims 1, 11, and 14. Rather, the examiner merely alleged an alternative to sending a request from a referring physician *in the form of a decision tree of exams to be performed on the patient*. The examiner alleged that "[a] doctor could simply utilize the resulting medical examinations of his/her patients to determine if additional medical examinations or doctor's appointments are further needed." See *id.* The applicants contend that this is clearly insufficient to support a *prima facie* case of obviousness. As such, the applicants reiterate that Teshima and Campbell do not teach or suggest all of the features recited by the present claims. In particular, Teshima and Campbell fail to teach or suggest "sending a request for ordering exams to be performed on a patient to a scheduler, the request being sent by a referring physician *in the form of a decision tree of exams to be performed on the patient*," as recited by independent claims 1, 11, and 14.

For at least these reasons, the applicants respectfully submit that independent claims 1, 11, and 14, and the claims depending therefrom, are not rendered obvious by a hypothetical combination of Teshima and Campbell. Accordingly, the applicants respectfully request withdrawal of the rejection of claims 1-16 under 35 U.S.C. § 103 based on a hypothetical combination of Teshima and Campbell.

***Deficiencies of the rejection of independent claims 17, 24, and 25 based on a hypothetical combination of Teshima and Campbell.***

The applicants also contend that Teshima and Campbell, whether alone or in hypothetical combination, fail to disclose each element of independent claims 17, 24, and 25. For instance, independent claims 17, 24, and 25 all generally recite, *inter alia*, “generating a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams.*” (Emphasis added.)

The applicants contend that a hypothetical combination of Teshima and Campbell fails to disclose “generating a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams,*” as generally recited by independent claims 17, 24, and 25. Indeed, the applicants note that the examiner has provided no specific rationale as to why the hypothetical combination of Teshima and Campbell renders independent claims 17, 24, and 25 obvious. Rather, in the final office action, the examiner merely stated that “[c]laims 14-25 recite limitations that have been addressed in the claims above. Therefore, claims 14-25 are rejected for similar reasons.” *See id.* at page 18.

However, the applicants note that the claim language recited by independent claims 17, 24, and 25 is different than that recited by independent claims 1, 11, and 14, discussed above. Nevertheless, from the examiner’s statement, it can reasonably be assumed that the same rationale for rejecting independent claims 17, 24, and 25 is being used by the examiner as in the rejection of independent claims 1, 11, and 14. In particular, the applicants believe that the examiner contends that the Teshima reference discloses “generating a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams*” based on the same passages cited by the examiner with respect to the rejection of independent claims 1, 11, and 14.

However, as discussed above, the applicants contend that the passages of Teshima cited by the examiner merely disclose (1) that an examination may be ordered based on a patient's main complaint and observed physical findings, (2) the first few steps in a process of assisting a physician in entering consultation information into a portable patient identification card (e.g., does the information being input into the patient identification card relate to a first consultation or a subsequent consultation), and (3) that the contents of the portable patient identification card may be read, previous consultation records may be listed, and a new consultation record may be created and updated. Nowhere in these three passages does Teshima suggest that a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams*, may be generated. Furthermore, the applicants contend that there are no other passages within Teshima or Campbell that disclose this recited subject matter.

In the Response to Arguments section of the final office action, the examiner stated that "both Campbell and Teshima's systems and method provide deductive reasoning needed to make a decision and request medical examinations. A hierarchical listing of exams is simply any form of logic used to determine if additional medical examinations or doctor's appointments are further needed, while diagnosing or processing a prognosis." *See id.* at page 23.

Therefore, it appears that here again the examiner, instead of identifying any passages in Teshima or Campbell that disclose the recited features, has merely attempted to downplay the significance of the recited features. More specifically, the applicants again note that the examiner has not identified any passages in Teshima or Campbell that disclose "generating a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams*," as

generally recited by independent claims 17, 24, and 25. Rather, the examiner alleged that “[a] hierarchical listing of exams is simply any form of logic used to determine if additional medical examinations or doctor’s appointments are further needed, while diagnosing or processing a prognosis.” *See id.* However, the applicants contend that “logic used to determine if additional medical examinations or doctor’s appointments are further needed” does not equate to generating a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams.* Rather, the logic in Teshima and Campbell may be used to determine if a *single* medical examination or doctor’s appointment is needed. However, as discussed above, there appears to be no passages in Teshima or Campbell that teach or suggest “generating a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams,*” as generally recited by independent claims 17, 24, and 25.

For at least these reasons, the applicants respectfully submit that independent claims 17, 24, and 25, and the claims depending therefrom, are not rendered obvious by a hypothetical combination of Teshima and Campbell. Accordingly, the applicants respectfully request withdrawal of the rejection of claims 17-25 under 35 U.S.C. § 103 based on a hypothetical combination of Teshima and Campbell.

***Deficiencies of the rejection of claims 2, 11, and 14 based on a hypothetical combination of Teshima and Campbell.***

The applicants also contend that Teshima and Campbell, whether alone or in hypothetical combination, fail to disclose each element of claims 2, 11, and 14. For instance, claims 2, 11, and 14 all generally recite, *inter alia*, “the decision tree comprises additional exams to be performed on the patient based on results of exams which were performed on the patient; exam specifications for all exams mentioned in the decision tree, the exam specifications for an exam specifying a manner in which the exam is to be performed; and expected results for all exams mentioned in the decision tree.”

As stated above, because Teshima fails to disclose the use of requested exams *in the form of a decision tree of exams to be performed on the patient*, the applicants further contend that Teshima does not disclose the specifics of what the decision tree comprises, as recited by claims 2, 11, and 14. More specifically, because Teshima does not disclose requested exams *in the form of a decision tree of exams to be performed on the patient*, Teshima cannot possibly disclose that the decision tree comprises “additional exams to be performed on the patient based on results of exams which were performed on the patient; exam specifications for all exams mentioned in the decision tree, the exam specifications for an exam specifying a manner in which the exam is to be performed; and expected results for all exams mentioned in the decision tree,” as recited by claims 2, 11, and 14.

For at least these reasons, among others, the applicants respectfully submit that claims 2, 11, and 14, and the claims depending therefrom, are not rendered obvious by a hypothetical combination of Teshima and Campbell. Accordingly, the applicants respectfully request withdrawal of the rejection of claims 2 and 11-16 under 35 U.S.C. § 103 based on a hypothetical combination of Teshima and Campbell.

**Conclusion**

In view of the remarks set forth above, the applicants respectfully request allowance of the pending claims. If the examiner believes that a telephonic interview will help speed this application toward issuance, the examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: February 23, 2010

/Steven J. Sinclair, Jr./

Steven J. Sinclair, Jr.  
Reg. No. 62,197  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545